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APPLICATION NO. 09/192,583	FILING DATE 11/17/95	FIRST NAMED INVENTOR MOTOYAMA	ATTORNEY DOCKET NO. 5244-0084-2X
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EXAMINER HO, C

ART UNIT 2153	PAPER NUMBER
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DATE MAILED: 07/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/192,583

Applicant(s)
Motoyama

Examiner
Ho

Art Unit
2153



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Apr 26, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-53 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-53 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9

20) ☐ Other:

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1. The amendment filed 04/24/01 have been entered and made of record.
2. Applicant's arguments with respect to claims 1-53 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 3, 8, 12-17, 20, 23-25, 34, 35, 36, 37-39, 42, 45, 46, 48, 50, 51, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwabara (U.S. Patent No. 6,065,136) in view of McCormick et al. (U.S. Patent No. 6,023,723).

In the claim 1, Kuwabara discloses a program for trouble shooting inspection is set in the form of electronic mail by the mail setting program and to User A through the Internet communication from the trouble diagnosing computer ; comprising:

- ◆ receiving an electronic mail message by a computer (Computer C1);
- ◆ determining whether the message which has been received is for a device (Main part 11) associated with the computer (Computer C1) (see figure 1, figure 2, , col.5, lines 65-67, col.6, lines 1-22);

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- ◆ transmitting a communication from the computer (Computer C1) to the device (Main Part 11), when the step of determining determines that the message is for the device (Main Part 11) (see figure 1, figure 2, col.5, lines 65-67, col.6, lines 1-22, col.4, lines 33-34).

However, Kuwabara does not disclose determining whether the message which has been received is for a device associated with the computer by detecting a characteristic of the e-mail, the device being a business office device including a processor.

McCormick et al. discloses determining whether the message which has been received is for a device (computer) associated with the computer (a system of filtering e-mail) by detecting a characteristic of the e-mail, the device being a business office device (computer) including a processor(see abstract, a filter is provided including character strings which the user wishes to receive, see figure 2).

Given the teaching of McCormick, it would have been obvious to one of ordinary skill in the art at the time of the invention to have Kuwabara's system detect characteristic of the e-mail in order to automatically detect email directed to control of business office device because it would have enable automated remote diagnostic of the business machine via electronic mail message.

5. In the claim 2, Kuwabara discloses determining whether the message which has been received is for the device or whether the message which has been received has been received has a user of the computer as an end recipient (see col.5, lines 65-67, col.6, lines 1-22).

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6. In the claim 3, Kuwabara discloses displaying, after the receiving step, a message to the user indicating the electronic mail message contains information to be forward to the device, wherein the determining step comprises: determining by a user reading the message which has been displayed, whether the message which has been received is for the device (see col.5, lines 65-67, col.6, lines 1-22).

7. In the claim 8, Kuwabara discloses receiving an Internet electronic mail message (see col. 6, lines 13-16).

8. In the claims 12, 34, Kuwabara discloses determining that the message is for a device automatically by detecting a characteristic of the email (see col.6, lines 1-17).

9. In the claims 13, 35, Kuwabara discloses determining that the message is for a device automatically by detecting a code within the message (see col.6, lines 1-35).

10. In the claims 14, 15, 36, 37, Kuwabara discloses determining that the message is for a device automatically by detecting the code which is the subject of the message (see col.5, lines 10-20, col. 6, lines 1-35).

11. In the claims 16, 38, Kuwabara discloses the determining step is performed in response to a receipt of an incoming electronic mail message (see col.5, lines 50-67, col.6, lines 1-3).

12. In the claims 17, 39, Kuwabara discloses the determining step is performed in response to a receipt of an incoming electronic mail message which is detected by monitoring an existence of

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a file stored at a predetermined location in memory (see figures 3-4, col.5, lines 50-67, col.6, lines 1-3).

13. In the claims 20, 42, Kuwabara discloses the computer is a message transfer agent, the step of transmitting information from the device transmits the information from the device directly to the computer which is the message transfer agent, and the step of transmitting the electronic mail message transmits the electronic mail message using a TCP connection from the computer which is a message transfer agent (see col.5, lines 1-67, col.6, lines 1-3).

14. In the claim 23, Kuwabara discloses a program for trouble shooting inspection is set in the form of electronic mail by the mail setting program and to User A through the Internet communication from the trouble diagnosing computer ; comprising:

- ◆ receiving an electronic mail message by a computer (Computer C1);
- ◆ determining whether the message which has been received is for a device (Main part 11) associated with the computer (Computer C1) (see figure 1, figure 2, , col.5, lines 65-67, col.6, lines 1-22);
- ◆ transmitting a communication from the computer (Computer C1) to the device (Main Part 11), when the step of determining determines that the message is for the device (Main Part 11) (see figure 1, figure 2, col.5, lines 65-67, col.6, lines 1-22, col.4, lines 33-34).

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However, Kuwabara does not disclose determining whether the message which has been received is for a device associated with the computer by detecting a characteristic of the e-mail, the device being a business office device including a processor.

McCormick et al. discloses determining whether the message which has been received is for a device (computer) associated with the computer (a system of filtering e-mail) by detecting a characteristic of the e-mail, the device being a business office device (computer) including a processor(see abstract, a filter is provided including character strings which the user wishes to receive, see figure 2).

Given the teaching of McCormick, it would have been obvious to one of ordinary skill in the art at the time of the invention to have Kuwabara's system detect characteristic of the e-mail in order to automatically detect email directed to control of business office device because it would have enable automated remote diagnostic of the business machine via electronic mail message.

15. In the claim 24, Kuwabara discloses determining whether the message which has been received is for the device or whether the message which has been received has been received has a user of the computer as an end recipient (see col.5, lines 1-67, col.6, lines 1-3).

16. In the claim 25, Kuwabara discloses for displaying a message to the user indicating the electronic mail message contains information to be forwarded to the device, wherein the means for determining comprises: means for determining , by a user reading the message which has

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been displayed whether the message which has been received is for the device (see col.5, lines 1-67, col.6, lines 1-3).

17. In the claims 45, 50, Kuwabara discloses receiving data from the device, in response to the step of operating the processor; creating an electronic mail message by the computer including the data which has been received; and transmitting over the Internet the electronic mail message generated by the computer (see figure 1-2, col.5, lines 1-67, col.6, lines 1-3).

18. In the claims 46, 51, Kuwabara discloses executing, by a device driver of the computer, commands for at least one of controlling and monitoring the device (see figure 1-2, col.5, lines 1-67, col.6, lines 1-3).

19. In the claims 48, Kuwabara discloses transmitting the communication as a command for processing by the processor of the device (see figure 1-2, col.5, lines 1-67, col.6, lines 1-3).

20. In the claim 52, Kuwabara discloses means for transmitting the communication as a command for processing by the processor of the device (see figure 1-2, col.5, lines 1-67, col.6, lines 1-3).

21. Claims 4, 5, 6, 7, 9, 26, 27, 28, 29, 30, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system of Kuwabara - McCormick in view of Forse'n (U.S.Patent No.6,073,166).

In the claims 4, 26, the combined system of Kuwabara and of McCormick discloses the substantial features as limitations of claim 3.

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However, the combined system of Kuwabara and of McCormick does not disclose executing a command which causes the step of transmitting to be performed.

Forse'n discloses module of executable code is derivable automatically for automatically starting the execution thereof together with the associated data when Internet Mail is read; comprising:

- ◆ executing a command which causes the step of transmitting to be performed.(see col.1, lines 10-24, lines 10-24, lines 30-35, col.2, lines 27-30, col.3, lines 1-2, lines 30-31, lines 42-45).

Given the teaching of Forse'n, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Kuwabara and of McCormick to execute a command which causes the step of transmitting to be performed. because E-mail messages transmit from the computer which is attached to the device which include information regarding the status or capabilities of the device. Therefore, the attached file is an executable file which allows a user A ("clicking" or "double-clicking") to execute the program code contained within the attached file.

22. In the claims 5, 27, Forse'n discloses executing program code of a file which is attached to the message by a manual action by the user (see col.3, lines 30-32).

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23. In the claims 6, 28, Forse'n discloses executing the program code of the file by pointing, using a pointing device and a graphical user interface, to an object representing the file (see col.3, lines 30-32).

24. In the claims 7, 29, Forse'n discloses executing the code by pressing a button while pointing to the object representing the file (see figure 3, col.3, lines 30-38).

25. In the claim 9, Kuwabara discloses the step or executing a command comprises transmitting information to a device driver executing within the computer; and the step of transmitting is performed using device driver (see figure 1, figure 2, col.2, lines 29-31, col.5, lines 65-67, col.6, lines 1-22).

26. In the claim 30, Kuwabara discloses the means for receiving an Internet electronic mail message (see col.5, lines 1-67, col.6, lines 1-3).

27. In the claim 31, Kuwabara discloses the means for executing a command comprises means for transmitting information to a device driver executing within the computer; and the means for transmitting operates using the device driver (see figures 1-2, User A-C or Users 1-3, col.5, lines 1-67, col.6, lines 1-3).

28. Claims 10, 11, 21, 22, 32, 33, 43, 44, 45, 47, 49, 53 are rejected under 35

U.S.C. 103(a) as being unpatentable over the combined system of Kuwabara - McCormick in view of Miyachi (U.S.Patent No 6,108,492).

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In the claims 10, 32, 45, the combined system of Kuwabara and of McCormick discloses the substantial features as limitations of claim 1.

However, the combined system of Kuwabara and of McCormick does not disclose receiving, by the device, the communication transmitted from the computer; and transmitting parameters from the device to the computer, in response to the communication which has been received by the device.

Miyachi discloses the present invention relates generally to method of scheduling and facilitating maintenance and repair of electronic equipment, more particular to devices use multifunction peripherals (printer, scanner, fax-data-voice (FDV) modem) which have advanced self-monitoring capabilities; comprising:

- ◆ receiving, by the device, the communication transmitted from the computer; and transmitting parameters from the device to the computer, in response to the communication which has been received by the device (see abstract, col.1, lines 65-67, col.2, lines 1-5, lines 25-35, col.3, lines 40-50, col.8, lines 60-67, col.9, lines 25-34, lines 40-47, col.10, lines 5-7, lines 28-67).

Given the teaching of Miyachi, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Kuwabara and of McCormick to receiving, by the device, the communication transmitted from the computer, and transmitting parameters from the device to the computer, in response to the communication which has been

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received by the device because it would have enable trouble diagnosing computer to know status information of devices before remoting diagnostic of the business office devices.

29. In the claims 11, 33, Miyachi discloses performing a mechanical action by the device, in response to the communication which has been received by the device (see col.3, lines 35-50, lines 60-67, col.8, lines 65-67, col.9, lines 25-35, lines 40-47, col.10, lines 5-7, lines 28-67).

30. In the claims 21, 43, Miyachi discloses creating a file corresponding to the information; and writing the file to database directory of the computer, and wherein the step of transmitting the message comprises transmitting the message corresponding to the information using the file stored in the database directory (see col.1, lines 65-67, col.2, lines 1-10, lines 25-35, col.3, lines 35-67, col. 5, lines 5-8, col.8, lines 60-67, col.9, lines 25-34, lines 40-47, col.10, lines 5-7, lines 28-67).

31. In the claim 22, 44, Miyachi discloses creating and writing comprises creating a plurality of files and writing the plurality of files in the database directory; and the step of transmitting comprises transmitting the message using each of the plurality of files stored in the database directory (see col.1, lines 65-67, col.2, lines 1-10, lines 25-35, col.3, lines 35-67, col. 5, lines 5-8, col.8, lines 60-67, col.9, lines 25-34, lines 40-47, col.10, lines 5-7, lines 28-67).

32. In the claims 47, 49, 53, Miyachi discloses wherein the business office device at least one of generates an image on a recording medium and scans an image on a recording medium (see col.2, lines 27-35).

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33. Claims 19, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system of Kuwabara - McCormick..

In the claims 19, 41, the combined system of Kuwabara and of McCormick discloses the substantial features as limitations of claim 18.

However, the combined system of Kuwabara and of McCormick does not disclose transmitting the information from the device driver to a message application programming interface (MAPI) of the computer; and processing the information by the MAPI, wherein the step of transmitting the electronic mail message comprises transmitting mail message corresponding to the information which has been processed by the MAPI.

It would have been obvious to modify the combined system of Kuwabara and of McCormick by employing message application program interface (MAPI) of the computer, and processing the information by the MAPI, wherein the step of transmitting the electronic mail message comprises transmitting mail message corresponding to the information which has been processed by the MAPI. It is standard for window operation system (see description of the preferred embodiments, page 29, lines 9-14).

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Claim Rejections - 35 USC § 102

34. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

35. Claims 18, 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Frantz (U.S. Patent No. 6,003,070).

In the claims 18, Frantz discloses an interface device that is either integral or peripheral to equipment that require monitoring and maintenance; comprises:

- ♦ transmitting information from a device (the equipment may be a PBX or ACD, by may include any of type of equipment) to a computer (the interpreter 16) associated within the device (the types of equipments), the device being a business office device including a processor (see col.2, lines 15-38, col.4, lines 10-40);
- ♦ processing the information by a device driver within the computer; and transmitting, by the computer, an electronic mail message corresponding to the information (see col. 4, lines 44-50, col.5, lines 1-67).

36. In the claim 40, Frantz discloses an interface device that is either integral or peripheral to equipment that require monitoring and maintenance; comprises:

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- ◆ transmitting information from a device (the equipment may be a PBX or ACD, by may include any of type of equipment) to a computer (the interpreter 16) associated within the device (the types of equipments), the device being a business office device including a processor (see col.2, lines 15-38, col.4, lines 10-40);
- ◆ processing the information by a device driver within the computer; and transmitting, by the computer, an electronic mail message corresponding to the information (see col. 4, lines 44-50, col.5, lines 1-67).

37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

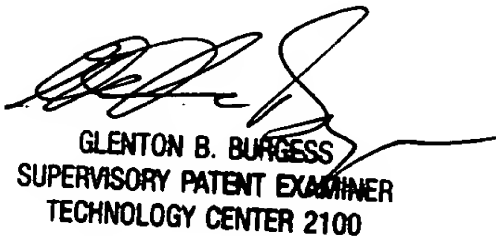
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Conclusion

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuong Ho whose telephone number is (703)306-4529. The examiner can normally be reached on Monday-Friday from 9am to 3pm.
39. If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Burgess, Glenton, can be reached on (703)305-4792.
- Any inquiry of a general nature or relating to the status of this application or proceeding should be direct to the group receptionist whose telephone number is (703) 305-3900.

CH

Date 06-21-01


GLENTON B. BURGESS
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